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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/161,138	09/25/98	EGELHOF	D P714-385

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EXAMINER
HASTINGS, K

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 01/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09161138

Applicant(s)

Egelhof et al

Examiner

Hasting

Group Art Unit

1731

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-25-98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 31-38 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 31-38 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,389,206; 5,500,091; 5,718,805; and 5,853,544. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely of slightly differing scope; for example, use of vacuum or not for the third section stationary drainage element would have been within the ordinary level of skill in the art as is the use of a suction roll for separating the twin wires (in the third section).

Claims 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 31 line 33 insert --then--before "across" to be clear about the location of the suction roll. Likewise in claim 35, line 33 insert -- then before "across" and in claim 37 line 43 change "and" to --followed by --.

Claim 33 is incomplete in failing to recite at least one stationary drainage element in the third section. Correction is necessary.

Claims 33 and 34 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A third section with a stationary drainage element is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). (The original specification and Jepson format of the claims clearly included a third section with a stationary dewatering element as an essential feature of the invention. Every figure shows section I, II, and III, and every section III includes a stationary dewatering element. Thus please amend claim 33 line 44 after "including" by inserting -- at least one stationary dewatering element followed -- before "a suction roll". Note in all instances, the suction roll 20 is in addition to stationary drainage element of the third dewatering section.

If a terminal disclaimer were filed and all changes made to it
Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Examiner Hastings whose telephone number is (703) 308-0470.

The examiner can normally be reached on Monday-Thursday from 6:30 am to 5:00 pm.

→ Obsolete 112 rejections, claims 31-38 would be allowable.

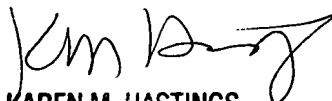
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stan Silverman, can be reached on (703) 308-3857. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Hastings/vr

12-23-98


KAREN M. HASTINGS
PRIMARY EXAMINER
GROUP 1300
12-98